

ESTTA Tracking number: **ESTTA442844**

Filing date: **11/23/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91197624
Party	Defendant CKM Holdings Inc.
Correspondence Address	MATTHEW J SMITH POL SINELLI SHUGHART PC 100 S. FOURTH ST, SUITE 1100 ST LOUIS, MO 63102 UNITED STATES uspt@polsinelli.com
Submission	Opposition/Response to Motion
Filer's Name	John M. Challis
Filer's e-mail	uspt@polsinelli.com, kgrady@polsinelli.com, jchallis@polsinelli.com,
Signature	/John M. Challis/
Date	11/23/2011
Attachments	STLOUIS-#510755-v1-CKM_23andMe_-_Opposition_to_Motion_to_Extend.pdf ( 5 pages )(30240 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 77/832463  
For **GENESIS BIOSCIENCES and Design**

---

23andMe, Inc.,

Opposer,

v.

CKM Holdings Inc.,

Applicant.

**APPLICANT’S OPPOSITION  
TO OPPOSER’S MOTION TO  
EXTEND DISCOVERY  
AND ALL  
SUBSEQUENT DATES**

Opposition No.: 91197624

---

**APPLICANT’S OPPOSITION TO OPPOSER’S MOTION TO EXTEND  
DISCOVERY AND ALL SUBSEQUENT DATES**

TBMP § 509.01 and Fed. R. Civ. P. 6 are clear that motions to extend time must demonstrate “good cause” and “must set forth with particularity the facts said to constitute good cause for the requested extension; mere conclusory allegations lacking in factual detail are not sufficient.” TBMP § 509.01. “[A] party moving to extend time must demonstrate that the requested extension of time is not necessitated by the party’s own lack of diligence or unreasonable delay in taking the required action during the time previously allotted therefor.” *Id.* “The Board will ‘scrutinize carefully’ any motion to extend time, to determine whether the requisite good cause has been shown.”

This matter has been pending for nearly twelve months and the discovery period opened over nine months ago on February 8, 2011. The discovery period has already been extended once by the agreement of the parties. And during that extension, no additional discovery has taken place. Now, in a last-minute attempt to continue to pursue unspecified discovery that Opposer failed to conduct during the 270 days that discovery was open in this matter, Opposer

has filed the instant Motion seeking to re-open a discovery period that has already closed. For the reasons set forth herein, because Opposer has failed to demonstrate the “good cause” required, its Motion should be denied and this matter should proceed without further delay.

After Opposer filed this matter challenging Applicant’s right to register its mark Genesis Biosciences (and design) based solely on the alleged similarity of the design portion of Applicant’s composite mark with the design portion of Opposer’s composite mark, the parties abided by the schedule set forth by the Board in exchanging initial disclosures. Opposer’s filing has delayed Applicant’s receipt of a registered trademark for over a year already. So from the beginning of this case, Applicant has wanted to move this case forward without delay because it perceives absolutely no likelihood of confusion between these composite marks – especially given the significant differences between the marks and the services and goods on which they are used. After discovery opened on February 8, 2011, Applicant timely served discovery on April 1, 2011. On May 6, 2011, Opposer provided its responses to discovery and almost a month later on June 1, 2011, produced its documents responsive to the Requests for Production.

Not until June 3, 2011, or nearly four months after discovery opened, did Opposer serve any discovery on Applicant. Discovery was initially set to close on August 7, 2011. In mid-June, the parties agreed to continue all of the remaining dates by ninety days, which meant that discovery would not close until the present deadline of November 5, 2011. In so agreeing to this extension, Applicant sought, and was granted, thirty additional days to serve its discovery responses. On August 8, 2011, Applicant timely served its discovery responses and thereafter produced responsive documents.

Following this document production on September 1, 2011, no further communication was received from Opposer until October 20, 2011 – only two weeks before the discovery

deadline. At no point during that (or any) timeframe did Opposer ever inquire regarding the alleged discovery deficiencies.<sup>1</sup> Nor during this or any timeframe did Opposer serve any additional discovery responses or request to take any depositions. In fact, to date, Opposer has made no statements regarding what additional discovery it needs to conduct other than “to ensure the parties obtain the necessary discovery.” *Motion*, p. 2. Opposer has not identified one person it desires to depose or any additional information or documents it needs to prosecute its specious case. Opposer failed to designate even one expert witness or proffer any opinions as to why this likelihood of confusion allegedly exists.

Applicant submits that it needs no additional discovery. Applicant is ready and willing to proceed in this matter in filing a Motion for Summary Judgment demonstrating exactly why Opposer’s case is without merit. Opposer, after failing to serve any discovery until nearly four months into the discovery period and failing to seek any additional discovery whatsoever, now seeks to further delay this matter and presumably burden Applicant with additional, unspecified discovery. No good cause exists for this extension.

Nor can the settlement discussions of the parties be used as an excuse for Opposer’s lack of diligence. Opposer waited to make any settlement offer until October 31, 2011 – just days before the extended discovery period was to close. Certainly, this does not explain why Opposer failed to conduct the discovery it now states is “necessary” for the eight months prior to that settlement offer. Nor do settlement discussions justify an extension. While Applicant is desirous of a mutually agreeable settlement offer, its initial offers have been rejected by Opposer and Applicant is considering whether or not it even wants to continue in said discussions or proceed swiftly with dispositive motions. Applicant has made it clear to Opposer that it is willing to

---

<sup>1</sup> In fact, the Motion filed by Opposer is the first time that Opposer has ever referenced any alleged deficiencies in Applicant’s discovery responses.

discuss potential resolution, but is not going to do so at the expense of moving this matter forward as scheduled.

Opposer has provided no good cause sufficient to justify this second extension of the discovery period and its lack of diligence should not be rewarded by re-opening a discovery period that is now closed. Opposer has not stated why it failed to serve the discovery it believes it now needs in this matter. Opposer has failed to even identify what additional discovery it needs to conduct. And Opposer has never identified any alleged deficiencies in Applicant's discovery responses. If this matter is to be resolved, it will be resolved irrespective of whether the discovery period is extended.<sup>2</sup>

Applicant strongly opposes this eleventh-hour attempt to extend the discovery period. Applicant desires to move forward substantively with this case and either resolve it by agreement of the parties or present the issues to the Board without further delay. For these reasons, Applicant respectfully requests that the Board deny Opposer's Motion to Extend the Discovery Period, leave the schedule undisturbed, and allow this matter to proceed without further delay.

Respectfully submitted,

POLSINELLI SHUGHART PC

By: /John M. Challis /

KEITH J. GRADY

JOHN M. CHALLIS

100 South Fourth Street, Suite 1000

St. Louis, Missouri 63102

Phone: (314) 889-8000

Facsimile: (314) 231-1776

E-Mails: kgrady@polsinelli.com  
jchallis@polsinelli.com

ATTORNEYS FOR APPLICANT  
CKM HOLDINGS, INC.

---

<sup>2</sup> Applicant submits that a resolution is more likely if the discovery period is not extended as it will force the parties to either resolve the matter or move forward with dispositive motions as opposed to continue the inaction that existed on settlement for almost the entire discovery period.

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the above and foregoing pleading was served by United States Mail, postage prepaid, this 23rd day of November 2011, to:

Beth M. Goldman  
Chelseaa Bush  
405 Howard Street  
San Francisco, California 94105  
(415) 773-5700

Attorneys for Opposer

/John M. Challis/